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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,625	09/17/2001	William T. Turner	12017-26/NEC	7554

7590

08/11/2003

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EXAMINER

WARREN, DAVID S

ART UNIT

PAPER NUMBER

2837

DATE MAILED: 08/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/954,625

Applicant(s)

TURNER, WILLIAM T. *ed*

Examiner

David S. Warren

Art Unit

2837

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 24-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24 – 33 and 37 – 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Freeman (3657461). Regarding claims 24 and 37 – 40, Freeman discloses a humbucking pickup (col. 2, lines 72 – 75) having two coils (26, 27) separated by a substantially planar ferromagnetic plate (20, col. 2, lines 67 – 71). All the limitations of claims 25 – 27 can be seen in Freeman's figures 3 – 5. Specifically, the ferromagnetic plate of Freeman separates the lines of force between north and south poles, it is arranged perpendicularly to the magnet, and the magnet is elongate. Regarding claim 28, a "bobbin" is considered any structure around which a coil is turned, i.e., this feature is inherent in the Freeman teaching. Regarding claim 29, the coils of Freeman are arranged one above the other. Regarding claim 30, see Freeman col. 2, lines 44 – 48 (i.e., coils are matched and opposite). Regarding claims 31 – 33, the ferromagnetic plate of Freeman is not connected to the magnetic pole pieces nor does it extend in either the upward or downward direction (figs. 3 – 5).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2837

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34 – 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman ('461) in view of Kinman ('5668520). The teachings of Freeman are discussed above regarding independent claim 24. Regarding claim 34, Freeman does not teach the use of metal plates attached to the side of a pickup. Kinman shows elements U-shaped shields (21, 40) that appear to perform an equivalent function as that of claim 34 (applicant admits that steel and ferromagnetic materials are equivalent – see specification page 12, lines 1 and 2). It would have been obvious to one of ordinary skill in the art to combine the teachings of Kinman with those of Freeman to obtain a pickup with metallic sidepieces to modify the magnetic lines of force (i.e., inductance). The motivation for making this combination lies in the Kinman reference, whose invention seeks to shield the coils not only from one another, but also from external noise. Regarding claims 35 and 36, Freeman discloses the claimed invention except for the dimensions of thickness for the ferromagnetic plate. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a plate of at least 0.1 inches, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (*In re Aller*, 105 USPQ 233.) *In re Woodruff*, 919 F. 2d 1575 (Fed. Cir. 1990) requires the applicant to set forth reasons that "show that the claimed range achieves unexpected results relative to the prior art." The examiner does not

believe that applicant's discussion (see applicant's specification, the paragraph bridging pages 7 and 8) of plate thickness shows "unexpected results" over the prior art.

***Conclusion***


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patent to Anderson ('117) shows a two-coil humbucking pickup having the coils separated by a ferromagnetic plate (20, fig. 3). The patents to Lace, Jr. ('578) and Stich ('751) disclose a metal side plate (23 in Stich, 13 of Lace).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David S. Warren whose telephone number is 703-308-5234. The examiner can normally be reached on M-F, 9:30 A.M. to 6:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Nappi can be reached on 703-308-3370. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-9529 for regular communications and 703-872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

dsw  
July 29, 2003

  
ROBERT E. NAPPI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800